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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/914,536 08/19/97 STEVENSON

M STEVE-106

IM22/0707

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EXAMINER

CAMERON, E

ART UNIT

PAPER NUMBER

1762

DATE MAILED:

07/07/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/914,536

Applicant(s)
Stevenson et al

Examiner
Erma Cameron

Group Art Unit
1762



☒ Responsive to communication(s) filed on Jun 13, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1, 2, 5, 7, 8, 15-17, 20, and 39-55 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1, 2, 5, 7, 8, 15-17, 20, and 39-55 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Response to Amendment

Applicant's arguments filed 6/13/2000 have been fully considered but they are not persuasive.

Claim Rejections - 35 USC § 112

1. Claims 40 and 41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A) Claims 40 and 41: there is no antecedent basis for step.

This rejection was not addressed in the 6/13/2000 amendment.

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2. Claims 1 and 47 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the composition as claimed in Claim 1 as originally filed, does not reasonably provide enablement for the broader composition of Claim 1 or Claim 47. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

Applicant's arguments presented in the 6/13/2000 amendment that they have removed the percentage limitations in order to claim priority to 08/566906 is not found persuasive; there is no evidence that limitations outside the scope of the originally filed claims 1 and 47 would be operative in the claimed invention.

3. Claim 1 and 47 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

New matter: the following are considered to be new matter, not supported by the specification as originally filed -

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a) Claim 1: "...powder in an amount sufficient to fuse into and form a permanent bond with the molded polyethylene article..." .

Applicant's argument that page 9:29-35 supports the wording powder in an amount sufficient to fuse into and form a permanent bond is not supported by 9:29-35 compositions...forming a permanent bond between the coatings and the polyolefin surface.

9:29-35 refers to a permanent bond between the composition as a whole and the polyolefin, and does not suggest that the powder must be in an amount sufficient (a critical amount), or that the permanent bond is specifically between the powder and the polyolefin.

Nor does not wording of 17:6-8 suggest that the powder must be in an amount sufficient to fuse into and form a bond with the polyolefin.

b) Claim 47: "...powder that is adapted to fuse into and form a permanent bond with the molded polyethylene article..."

9:29-35 refers to a permanent bond between the composition as a whole and the polyolefin, and does not suggest that the bond is specifically between the powder and the polyolefin.

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Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-2, 5, 7-8, 15-17, 20 and 39-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 96/23041.

'041 teaches a thermoplastic spray material for bonding to polyethylene (p4) where the composition comprises 5-95% polyethylene powder with particle size less than 50 microns (p18-19), organic or inorganic pigments or mixtures, organic solvents or water or mixtures (p19), and resin particles such as rosins or hydrocarbon resins (p21). After application to a surface, the composition is heated (p20).

The composition of '041 overlaps with applicant's claimed ranges.

The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have selected the overlapping portion of the range disclosed by the reference because overlapping ranges have been held to be a prima facie case of obviousness. See *In re Malagari* 182 USPQ 549.

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'041 does not teach a clear overcoat, but a color-plus-clear type of surface coating is conventional to the art, and it would have been obvious to one of ordinary skill in the art at the time the invention was made to have added a protective clear overcoat to the pigmented coating of '041, for protection.

The present application is not entitled to the filing date of 08/566906 because the present application recites a coating composition and process (20-90 percent liquid carrier, 9-50 % colorant + 50-91 % of binder and particulate thermoplastic powder , to be applied to a molded article) that is different from that of 08/566906 (thermoplastic or thermosetting resin, liquid carrier, binder solid and optional colorant, to be applied to a mold surface). See MPEP 201.11.

Regarding the argument in the 6/13/2000 amendment that the difference is only in the timing of the incorporation, the specification (08/914536) at page 2, lines 1-12 states very specifically that the invention is to decorate a preformed polyolefin article. This makes the timing critical.

The applicant has presented no arguments regarding this rejection in the 6/13/2000 amendment.

The polyethylene article supplied with the 6/13/2000 amendment is not relevant to the question of whether the present application is entitled to the 08/566906 filing date, because the relevant

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question is the intention of the 08/914536 specification as originally filed, which was to the application of a composition to a preformed polyolefin article.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Erma Cameron
**ERMA CAMERON
PATENT EXAMINER
GROUP 1100**

Erma Cameron

July 6, 2000